

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Ginsberg et al. Art Unit : 3714
Application No. : 09/846,025 Confirmation No. : 4295
Filed : April 30, 2001
Title : REAL-TIME INTERACTIVE WAGERING ON EVENT OUTCOMES
Examiner : Corbett B. Coburn

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

MISCELLANEOUS COMMUNICAITON

This paper is submitted in response to the communication of August 5, 2010. Applicants thank the Examiner for a phone discussion on August 9, 2010 in which the Examiner identified that Applicants should submit this paper in response to the August 5, 2010 communication.

The communication of August 5, 2010, which refuses to enter Applicants' reply to the examiner's answer, which includes a new grounds of rejection, does not comply with the binding examination procedures imposed by the MPEP. It should therefore be revoked, prosecution must be reopened, Applicants' reply must be entered, and Applicants' reply must be considered.

First, MPEP 1207.03(V)(A) third paragraph, which is binding on the examination of patents by the USPTO states, in part:

Once appellant files a reply in compliance with 37 CFR 1.111 in response to an examiner's answer that contains a new ground of rejection, the examiner must reopen prosecution by entering and considering the reply.

Applicants have filed a reply in compliance with 37 CFR 1.111. Clearly, based on this portion of the MPEP, in response to that reply, prosecution must be reopened, that reply must include be

enter, and that replay must be considered. Must is a binding word that places an affirmative duty on the Office. The MPEP does not provide any deference to the Office to refuse to take any of these actions regardless of whether there are amendments in the reply that do not address a new grounds of rejection in the examiner's answer. Nonetheless, the communication of August 5, 2010, attempts to refuse to take these actions. It is therefore in violation of the MPEP and must be revoked.

Second, MPEP 1207.03(V)(A) first paragraph, which is binding on the Examination of patents by the USPTO states, in part:

If appellant requests that prosecution be reopened, the appellant must file a reply that addresses each new ground of rejection set forth in the examiner's answer in compliance with 37 CFR 1.111 within two months from the mailing of the examiner's answer. The reply may also include amendments, evidence, and/or arguments directed to claims not subject to the new ground of rejection or other rejections.

Applicants have filed a request that prosecution be reopened and a reply that addresses each new ground of rejection in compliance with 37 CFR 1.111 within the two months of the mailing of the examiner's answer. Clearly, based on this portion of the MPEP, that reply may include amendments that are not limited to just the new grounds of rejection. So, even without the third paragraph's affirmative duty discussed above, Applicants would still be allowed to make any amendments desired in the reply and have prosecution reopened, the reply entered, and the reply considered..

Accordingly, the paper of August 5, 2010 must be revoked and the Office must reopen prosecution, must enter the reply and must consider the reply.

Respectfully submitted,

Dated: August 9, 2010

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